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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,766	07/18/2000	Matthew W. Milne	K35A0625	8824

7590

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EXAMINER

NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,766

Applicant(s)

MILNE ET AL.

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1 – 17 are presented for consideration.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following terms lack antecedent basis:

- I. the firmware - claim 3.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5, 10, 11, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klimenko [US Patent No 5,974,547], in view of Hubacher et al. [US Patent No 6,487,601].

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6. As per claim 1, Klimenko discloses the invention substantially as claimed including a method of delivering content from a content delivery server to a personal computer system that includes a computing subsystem and a disk drive, the method comprising:

selecting a network address for the content delivery server [col 10, lines 57-col 11, lines 7];

selecting a server-contacting program [col 7, lines 62-col 8, lines 6];

configuring the content delivery server [col 11, lines 34-49], the configuring comprising:

receiving user information from the personal computer system while the personal computer system is connected to the content delivery server [col 11, lines 50-65]; and

delivering content to the personal computer system in response to the user information [col 11, lines 66-col 12, lines 31].

Klimenko does not specifically disclose

storing the network address and the server-contact program in the disk drive;

installing disk drive executable code in the disk drive to initiate execution of the server-contacting program after the disk drive is connected to the computing subsystem in the personal computer system, wherein execution of the server-contact program includes using the network address for connecting the personal computer system to the content delivery server.

Hubacher discloses

storing the network address and the server-contact program in the disk drive [col 6, lines 22-col 7, lines 21];

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installing disk drive executable code in the disk drive to initiate execution of the server-contacting program after the disk drive is connected to the computing subsystem in the personal computer system, wherein execution of the server-contact program includes using the network address for connecting the personal computer system to the content delivery server [col 2, lines 46-67].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Klimenko and Hubacher because Hubacher's teaching would provide a more efficient method for distributing content to multiple users.

7. As per claim 2, Klimenko does not specifically disclose a protected area; and the network address and the server-contacting program are stored in the protected area. Hubacher discloses a protected area; and the network address and the server-contacting program are stored in the protected area [col 6, lines 1-16]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Klimenko and Hubacher because Hubacher's teaching of protected are would allow to protect files to prevent system corruption.

8. As per claim 3, Klimenko discloses the firmware resides in the disk controller circuit [334, Figure 3].

9. As per claim 5, Klimenko discloses the personal computer system displays the content during a boot sequence [col 3, lines 10-13].

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10. As per claim 10, it is apparatus claimed of claim 1, it is rejected for similar reasons as stated above in claim 1. Furthermore, Klimenko discloses a database including the user information associated with the disk drive in the personal computer system [Figure 2B; and].

11. As per claim 11, Klimenko discloses the disk controller circuit automatically initiates execution of the server-contacting program when the disk drive is connected to the computing subsystem in the personal computer system [col 12, lines 56-65].

12. As per claim 15, it is apparatus claimed of claim 5, it is rejected for similar reason as stated above in claim 5.

13. Claims 4, 7-9, 12-14, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klimenko [US Patent No 5,974,547], in view of Hubacher et al. [US Patent No 6,487,601], and further in view of Welder [US Patent No 6,473,855].

14. As per claim 4, Klimenko and Hubacher do not specifically disclose the disk drive executable code delays initiating execution of the server-contacting program until a predetermined period has lapsed. Welder discloses the disk drive executable code delays initiating execution of the server-contacting program until a predetermined period has lapsed [Figure 4A]. It would have been obvious to a person skill in the art at the time the invention was

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made to combine the teaching of Klimenko, Hubacher and Welder because Welder's teaching would provide additional option for user to interrupt the process for other tasks or purposes.

15. As per claim 7, Klimenko and Hubacher do not specifically disclose the disk drive executable code delays initiating execution of the server-contacting program until the disk drive executable code determines that a selected number of monitored events exceeds a threshold. Welder discloses the disk drive executable code delays initiating execution of the server-contacting program until the disk drive executable code determines that a selected number of monitored events exceeds a threshold [col 11, lines 20-46]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Klimenko, Hubacher and Welder because Welder's teaching would allow to monitor the workload to increase system performance.

16. As per claim 8, Welder discloses the monitored events includes the number of boot-ups in the computing subsystem [col 2, lines 26-31].

17. As per claim 9, Welder discloses the content is selected from the group comprising: a content display program, a game, an entertainment program, a utility program, entertainment data, advertisement data, and music data [col 2, lines 51-55].

18. As per claim 12, it is apparatus claimed of claim 4, it is rejected for similar reasons as stated above in claim 4.

19. As per claims 13 and 14, they are apparatus claimed of claims 7 and 8, they are rejected for similar reasons as stated above in claims 7 and 8.

20. As per claim 17, it is apparatus claimed of claim 9, it is rejected for similar reason as stated above in claim 9.

21. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klimenko [US Patent No 5,974,547], in view of Hubacher et al. [US Patent No 6,487,601], and further in view of Peterson et al. [US Patent No 6,594,682].

22. As per claim 6, Klimenko and Hubacher do not specifically disclose the content is periodically changed according to a presentation schedule. Peterson discloses the content is periodically changed according to a presentation schedule [col 6, lines 38-52]. It would have been obvious to a person skill in the art at the time at the time the invention was made to combine the teaching of Klimenko, Hubacher and Peterson because Peterson's teaching of changing content would allow content to be updated more often to fit customer's need and provide more valuable information.

23. As per claim 16, it is apparatus claimed of claim 6, it is rejected for similar reasons as stated above in claim 6.

24. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

25. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (703) 305-5321. The examiner can normally be reached on Monday – Friday (8:00 – 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directly to the receptionist whose telephone number is (703) 305-3900.

Dustin Nguyen


JOHN FOLLANSBEE
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